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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

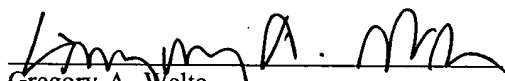
Assignee's Docket No.: 8580)
Group Art Unit: 3624)
Serial No.: 09/826,678)
Examiner: Dan Kesack)
Filing Date: April 5, 2001)
Title: Transaction Terminal)
Interface)
_____)

APPEAL BRIEF
A Summary of Argument Begins on Page 7

The fee for this Brief may be billed to Deposit Account 14 -
0225, NCR Corporation.

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Gregory A. Welte



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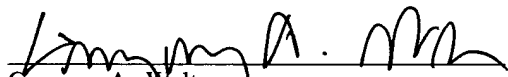
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1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1 - 6, 8, 10, and 21 - 26 are rejected.

Claims 7, 9, and 11 - 20 are cancelled.

Claims 1 - 6, 8, 10, and 21 - 26 are appealed.

4. STATUS OF AMENDMENTS

No amendments-after-final have been submitted.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Summary

Figure 1 shows a portable device 10 which a user maintains in a motor vehicle. The user drives the vehicle, containing the device 10, to an Automated Teller Machine, ATM. (Specification, page 7, lines 1, 2.)

The ATM transfers computer programs to the device 10, and the programs generate an interface in the device 10. (Page 7, lines 8 - 10.)

Then the user interacts with the device 10, in order to execute a transaction with the ATM. (Page 7, lines 11 - 21.)

Concise Explanation of Independent Claims

Claim 1

Claim 1 states that a vehicle pulls up to a transaction terminal, computer programs are transferred from the terminal into a device in the vehicle, and the device is used to execute a transaction with the terminal.

Support for the recitations of the claim are found at the following locations **printed in bold type**:

1. A method of conducting a transaction from within a vehicle, the method comprising the steps of:

locating the vehicle adjacent a transaction terminal
(Page 2, line 20; page 7, lines 1, 2);

transferring one or more computer programs from the transaction terminal to an in-car data entry facility maintained within the vehicle, which programs generate a user interface in the entry facility **(page 7, lines 7 - 10);**

entering user instructions into the in-car data entry facility **(page 7, lines 11 - 16);**
and

transmitting the user instructions locally to the terminal for execution by the terminal
(page 7, lines 12 - 16).

Claim 8

Claim 8 recites an apparatus in a vehicle, which receives

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programs from an external terminal, which run on the apparatus and generate an interface in the apparatus. The apparatus transfers data to the external terminal.

Support for the recitations of the claim are found at the following locations **printed in bold type**:

8. An in-car apparatus to be provided within a vehicle for user interfacing with a transaction terminal, the apparatus comprising:

means for interacting with a user (**page 7, lines 1, and 11 - 16; keypad 16 and display 12 in Figure 1**);

means for receiving a computer program from the transaction terminal which generates an interface in the apparatus (**page 7, lines 7 - 10; transceiver 26 in Figure 2, and associated software and hardware in unit 30**);
and

means for transmitting data locally to a transaction terminal situated adjacent the apparatus (**page 7, lines 15, 16; transceiver 26 in Figure 2, and associated software and hardware in unit 30**).

Claim 21

Claim 21 recites maintaining a communication device within a vehicle, establishing communication between the device and an ATM, Automated Teller Machine, entering identification data into the communication device, and proceeding with a financial transaction if the ATM accepts the identification data.

Support for the recitations of the claim are found at the

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following locations **printed in bold type**:

21. A method, comprising:

- a) maintaining a wireless communication device within a vehicle (**page 6, lines 5 - 7; page 7, line 1**);
- b) positioning the vehicle near an Automated Teller Machine, ATM (**page 7, lines 1, 2**);
- c) establishing wireless communication between the wireless device and the ATM (**page 7, lines 5 - 7**);
- d) entering identification data into the wireless device, which data allows the ATM to verify identity of a user (**page 7, lines 11 - 13**); and
- e) if the ATM verifies the user, proceeding with a financial transaction (**page 7, lines 11 - 21**).

Claim 25

Claim 25 recites maintaining a wireless communication device in a vehicle, entering a card and a PIN to the device, transferring data from the card and the PIN to an ATM, and proceeding with a financial transaction if the ATM accepts the identification data.

Support for the recitations of the claim are found at the following locations **printed in bold type**:

25. A method, comprising:

- a) maintaining a wireless communication

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device within a vehicle, said device comprising a keypad and a card reader (**page 6, lines 5 - 7; page 7, lines 1, 11, and 12);;**

b) positioning the vehicle near an Automated Teller Machine, ATM (**page 7, lines 1, 2; page 1, lines 4, 5);**

c) establishing wireless communication between the wireless device and the ATM (**page 7, lines 5 - 7);**

d) inserting a card into the card reader (**page 6, line 20; page 7, lines 11, 12);**

e) entering a PIN into the keypad (**page 7, line 12);**

f) relaying data from the card, and the PIN, to the ATM (**page 7, lines 11 - 13); and**

g) if the card and the PIN are accepted by the ATM, proceeding with a financial transaction (**page 7, line 13 et seq.**).

Support for Dependent Claims

Claim 4

Recites retrieving cash from the terminal/ATM. See Specification, page 3, line 27.

Claims 22 and 26

Claims 22 and 26 recite transferring programs from an external terminal to a device in a vehicle. Support for this is found in the Specification at page 7, lines 7 - 10; transceiver 26 in Figure 2, and associated software and hardware in unit 30.

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Claim 23

Claim 23 depends from claim 21, and states that the "identification data" is obtained from a card given to the device. The Specification, page 3, lines 4 - 10, and page 4, lines 7 - 14 discusses this.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1 - 4, 8, and 10 under 35 USC § 103, based on Treyz and Swaine.

The rejection of claims 5 and 6 under 35 USC § 103, based on Treyz, Swaine, and Ramachandran.

The rejection of claims 21 - 26 under 35 USC § 103, based on Treyz and Swaine.

7. ARGUMENT

SUMMARY OF MAIN POINTS OF ARGUMENT

Claims 1, 8, 22, and 26

These claims recite transferring programs to a device maintained within a vehicle, which programs generate an interface in the device.

Those recitations have not been shown in the applied references. Thus, the rejections cannot stand.

MPEP § 2143.03 states:

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To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

The Final Office Action, page 2, bottom, attempts to show these recitations in the references by pointing to "software" supposedly found in Treyz at two locations: column 50, lines 47 - 50 and Figure 9.

However, Figure 9 merely shows a display on a computer. (See column 4, lines 46 - 49). Plainly, that does not show the claim recitations in question.

The other location states:

The user may pay for the parking transaction using credit card information or other financial transaction information stored locally in automobile 12 or may use an account or other financial information arrangement that is maintained on a server or the like that is external to automobile 12.

(Treyz, column 50, lines 47 - 50.)

Plainly, again, that does not show the claim recitations in question.

The Final Action, page 3, section 5, asserts that the claim recitations in question are shown at three other locations in Treyz. This assertion is rebutted in the discussion of claim 21, below, in the heading entitled "Point 2," near page 36.

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Claim 25

Claim 25 recites:

- a) maintaining a wireless communication device within a vehicle, said device comprising a keypad and a card reader;
-
- d) inserting a card into the card reader.
- e) entering a PIN into the keypad;
-
- g) if the card and the PIN are accepted by the ATM, proceeding with a financial transaction.

These recitations have not been shown in the applied references.

As to the claimed "wireless communication device," a PC may be maintained in the vehicle of Treyz. But no

- entry of a PIN and card into the "device"
 - and
 - acceptance of the PIN-plus-card by the
- ATM,

as claimed, has been shown in Treyz.

The remote control unit 66 of Swaine is not "maintained" in the vehicle. Unit 66 is **permanently attached** to an ATM by cable 68. (See Figures 2 - 4). And no "card" is inserted into Swaine's remote control unit 66.

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Again, the claim recitations listed above have not been shown in the applied references.

Further, as just explained, the references are contradictory to each other, and to the claim. For example, Swaine states that the control unit 66 is **permanently attached to the ATM by cable 68**. Thus, it cannot be "maintained" in the vehicle. That is contrary to the claim, and contrary to Treyz.

This contradiction precludes combination of the references.

In order to address this contradiction, the Final Action, page 4, section 7, asserts that Swaine is cited for a limited purpose, and that the rejection does not rely on the contradictory elements of Swaine. Appellant points out that this selective reliance on a reference is not allowed.

One reason is that MPEP § 2141.03, last paragraph, states:

Prior art must be considered in its entirety,
including disclosures that teach away from
the claims.

A second reason is that the contradictory parts of Swaine which the PTO attempts to ignore are prior-art teachings. A teaching is required to ignore the contradictory teachings. None has been given.

All Claims: No Teaching Given for Combining References

No teaching has been given in favor of combining the

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references.

re: Teaching for Claims 1 - 4, 8, and 10

The first Office Action (mailed January 26, 2006) has only

- 1) set forth elements supposedly found in the two references, and then
- 2) concluded that it is obvious to combine those elements.

The final Office Action has merely repeated the position of the first Office Action. (Final Action, page 2, section 3.)

That is not a teaching under section 103. An explanation of **why** this combination of references is obvious must be given.

A valid teaching is required.

re: Teaching for Claims 21 - 26

The rationale given in the Final Office Action for combining Treyz with Swaine is that

- 1) the devices in the two references are "similar in form and function" and
- 2) Treyz teaches using his device at ATMs.

However, several problems exist in this rationale.

PROBLEM 1

One problem is that the second part of the rationale (Treyz

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teaches using his device in ATM) does not, as a matter of logic, lead to a combination of the references. It is simply a supposed fact about the Treyz reference. The other reference is not needed for this fact to be true, nor is the other reference needed for Treyz to operate as the fact asserts.

The existence of the fact, even if true, does not lead to a combination of the references.

PROBLEM 2

A second problem is that the mere fact that two references are "similar" is not, by itself, a teaching for combining the references.

PROBLEM 3

A third problem is that the rationale is, in fact, erroneous. The two devices in the two references are not "similar."

-- The device in Treyz is a personal computer, PC, 14 in his Figure 3.

-- The device in Swaine is a remote control unit 66 in his Figures 2 - 4.

Those two devices are **completely different**. They perform **completely different functions**. They **are not interchangeable**. For example:

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-- The PC 14 in Treyz can (1) run hundreds of off-the-shelf programs, (2) connect to the Internet, (3) store data on a hard drive, (4) play music and videos, etc.

-- The remote control unit 66 of Swaine is nothing more than a simple "dumb terminal."
It is an input-output device.

Appellant repeats: those two devices are **completely different**. They perform **completely different functions**. They **are not interchangeable**.

The Office Action is incorrect in stating that the two devices are "similar."

Therefore, the rationale for rejecting claims 21 - 26 contains two parts. One part (namely, Treyz teaches using his device at an ATM) is irrelevant.

The other part (namely, the devices in Treyz and Swaine are "similar") is completely erroneous.

Consequently, the rationale is not valid as a teaching for combining the references.

PROBLEM 4

A fourth problem is that no explanation has been given as to how this two-part rationale, even if correct, actually leads to the subject matter of claims 21 - 26.

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That is, the Office Actions merely

- 1) assert that individual claim elements are found in the two references and then
- 2) set forth the two-part rationale above, as a justification for combining the elements supposedly found.

But no logical connection has been given which leads from (2) to (1). For example, even assuming that the two-part rationale justifies combining the references, the PTO has not shown how the combination leads to the claims in question. The references can be combined in dozens of different ways, many of which do not show the claims.

For instance, it could be asserted that the PC 14 of Treyz should replace the remote control unit 66 of Swaine, with cable 68 still present. That combination does not show the claims.

- The PC is not "wireless" as claimed.
- No transfer of the "programs" which generate the "interface" as claimed is present.

From another point of view, in analyzing the combination of references, one starts with the two-part rationale. (One cannot start with the selected individual claim elements supposedly found in the references, because no basis exists for selecting those particular elements. The only basis would be Appellant's

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claims, which would be hindsight.)

Thus, again, one starts with the two-part rationale. Appellant now asks: based on this two-part rationale, what is the logical basis for selecting the individual claim elements from the references, and combining those elements into the claims ?

Appellant answers this rhetorical question: there is no logical basis. (Or at least none has been given.)

Therefore, until a line-of-reasoning is given which

- 1) starts with the two-part rationale and
- 2) ends with the claimed subject matter,

no valid teaching has been given in favor of combining the references.

PROBLEM 5

A fifth problem is that the two-part rationale is, in essence, identical to rationales which are prohibited by the MPEP.

MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE** COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references can be combined
or modified does not render the resultant
combination obvious unless the prior art also
suggests the desirability of the combination.

. . .

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FACT THAT THE CLAIMED INVENTION IS **WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART** IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

The two-part rationale, in essence, states that (1) the devices in the references are "similar" so that (2) any skilled person would know how to combine the references, and thereby obtain the claimed invention.

That is a forbidden rationale, as the MPEP sections just cited indicate.

PROBLEM 6

The rationales used in different 103 - rejections are self-contradictory.

The two Office Actions, in rejecting claims 1 - 4 and 8 - 10, assert that Treyz shows certain claim elements, but lacks other elements, which Swaine is said to show. Thus, in this rejection, the PTO states that Treyz is **different** from Swaine.

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The Final Action (page 3), in rejecting claims 21 - 26, asserts that Treyz and Swaine are "similar."

The PTO cannot, on the one hand, implicitly assert that Treyz and Swaine are **different**, and then explicitly assert that these two references are "similar."

That is inconsistent, and inconsistent reasoning is not allowed in two different 103 - rejections, based on identical references.

Comment

Not all points made in this Summary are elaborated below. Some are considered self-explanatory.

END SUMMARY

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ARGUMENT re: REJECTION OF CLAIMS 1, 4, 8 AND 10

CLAIM 1

Point 1

Claim 1 recites an "in-car data entry facility maintained within the vehicle."

The references are contradictory as to this recitation. Treyz, Figure 1, shows a personal computer 14 within an automobile 12. The only item in Swaine which could come close to this recitation is the remote control unit 66 in his Figures 2 and 3.

However, that remote control unit 66 is not "maintained within the vehicle" as claimed. That unit 66 is tethered to an ATM by an "armoured" "cable 68." (Column 3, lines 2, 3.) That unit 66 is **not removable**, and Swaine says so (column 3, lines 2, 3).

Swaine's remote control unit 66 is **permanently attached to his ATM**.

Therefore, the references are contradictory as to the claim recitation in question.

-- Treyz shows a PC in a car.

-- Swaine shows a remote control 66
permanently attached to an ATM.

Consequently, even if the references are combined, the claim recitation is not attained. (Which element of the prior art is

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found in the combination: The PC 14 of Treyz or the remote control 66 of Swaine ?)

Further, no teaching has been given which resolves the contradiction, and says whether the PC 14 of Treyz is selected, or the remote control 66 of Swaine.

Point 2

If the teachings of Swaine are followed, the claim is not attained.

As stated above, Swaine's remote control unit 66 is tethered to an ATM. Thus, if one follows Swaine's teachings, one does not attain an "in-car data entry facility maintained within the vehicle" as claimed. Swaine's unit 66 is not "maintained" within a vehicle.

In addition, claim 1 states that

- 1) computer programs are downloaded from the (external) terminal to the in-car device and
- 2) the downloaded programs generate a user interface.

If you follow Swaine's teachings, you do not attain these recitations either, for several reasons.

One Reason

One is that Swaine does not state that his remote control

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unit 66 contains a microprocessor which can run programs. Thus, there is no point in downloading programs to his remote control unit 66: the programs cannot run.

Second Reason

A second reason is that Swaine's remote control unit 66 in his Figure 2 appears to be nothing more than a keypad 72 combined with a display 70. The remote control unit 66 is nothing more than an input-output device. There is no reason to download programs to it.

Therefore, if you follow Swaine's teachings, you obtain neither of the following claim recitations:

- an "in-car data entry facility,"
- nor
- downloading programs to that "facility."

The prior art does not teach toward the claimed invention.

Point 3

As stated above, claim 1 states that

- 1) computer programs are downloaded from the (external) terminal to the in-car device and
- 2) the downloaded programs generate a user interface.

Those recitations have not been shown in either reference.

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MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

Point 4

The First Office Action (mailed January 26, 2006), page 3, bottom, states that Treyz fails to show

- locating the vehicle adjacent
the terminal,
- identifying the user, and
- retrieving cash from the
terminal.

Swaine is cited to show these elements.

However, the references are contradictory, and cannot be combined. Swaine shows a remote control 66 which is tethered to an ATM 42 by an armored cable 68. The cable 68 prevents thieves from stealing the remote control. (Column 3, top.) The remote control 66 stays with the ATM, and does not remain inside the customer's vehicle.

In contrast, Treyz shows a personal computer 14 (PC) within a vehicle, which can communicate wirelessly with outside terminals. (Column 47.) The PC remains in the vehicle, when the vehicle leaves a terminal.

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Therefore, the references are contradictory in at least the following respects.

-- One, Swaine shows a physical connection between the remote control 66 and the ATM, while Treyz shows none. That physical connection binds the remote control 66 to the ATM. The remote control 66 is non-removable.

-- Two, the personal computer (ie, a remote control) in Treyz is removable from the ATM, while Swaine teaches that the remote control 66 should not be removed from the ATM.

Contradictory references cannot be combined.

Point 5

The Final Action, page 4, attempts to resolve the contradiction of Point 4, by asserting that Swaine is cited **only to show an input device at an ATM**, and the computer of Treyz is substituted for Swaine's device. However, several problems exist in this assertion.

Problem 1

The notion of citing a reference for a specific purpose, and ignoring contrary teachings in the reference, is invalid. MPEP §

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2141.03, last paragraph, states:

Prior art must be considered **in its entirety**, including disclosures that teach away from the claims.

Problem 2

The Final Action, page 4, in attempting to resolve the contradiction, states: "Treyz has been modified to **INCLUDE the input device teachings of Swaine.**"

Appellant points out that this statement cannot be true. The input device of Swaine **cannot be included in Treyz.**

Swaine states that his input device 66 is **permanently tethered to his ATM by cable 68.** (Column 3, lines 1 - 3.) If that feature is included in Treyz, then both Swaine and Treyz are rendered inoperative.

MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED
PURPOSE.

THE PROPOSED MODIFICATION CANNOT CHANGE THE
PRINCIPLE OF OPERATION OF A REFERENCE.

Therefore, the PTO's assertion that Swaine is cited for a limited purpose of inclusion of his device into Treyz is an impossibility. Swaine's device cannot be substituted into Treyz.

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Problem 3

As explained immediately above, the Final Office Action states that "Treyz has been modified to include **the input device teachings of Swaine.**"

Appellant points out that this is a false statement for another reason. Swaine uses **wires** (ie, cable 68) to communicate between his unit 66 and his ATM. Treyz discusses **wireless** communication.

Thus, the Final Action's statement must be erroneous. How can the **wireless** device of Treyz "include" the "input device teachings of Swaine," when the latter are **hard-wired**, and not wireless ?

Problem 4

No teaching has been given for combining the references. The Office Action has only set forth elements supposedly found in the two references, and then concludes that it is obvious to add the elements of Swaine to Treyz.

But no explanation of **why** this addition is obvious has been given.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . After indicating that the rejection is under 35 U.S.C. 103, the examiner should set

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forth in the Office action:

. . . .

(D) an **explanation** why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . . .

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The "explanation," "suggestion," and "motivation" required by this MPEP section have not been set forth by the Office Action.

Point 6

The previous Point 5 discussed the PTO's attempt to cite Swaine for a limited purpose, and to ignore the contradictions between Swaine and Treyz. This Point 6 will continue with the defects in the combination of the two references, Treyz and

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Swaine.

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . . .

Second, there must be a reasonable expectation of success.

. . . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As explained above, Treyz operates wirelessly, while Swaine requires a cable. No explanation has been given as to how the wireless-reference is combined with the cable-reference.

Further, if wireless-operation is substituted for cable-operation (or vice-versa), then cable-operation (or wireless-operation) is eliminated. That renders one of the references unusable. MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED
PURPOSE.

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THE PROPOSED MODIFICATION CANNOT CHANGE THE
PRINCIPLE OF OPERATION OF A REFERENCE.

Point 7

The Final Action, page 4, bottom, states that

The input device modification of Treyz has
been made to . . . enhance the assertion that
an input interface device, as taught by
Treyz, can clearly [be used at an ATM].

Appellant points out that this is circular reasoning.

The PTO's statement, in essence, is that Treyz is modified,
based on Treyz' own teachings. If so, then where are the actual
teachings in Treyz which state that his input device should be
"enhanced" ?

Point 8

The Final Action, page 4, section 7, fourth sentence,
states:

Treyz clearly teaches an input device capable
of all the functions of the input device of
the present invention . . .

At least two problems exist in this statement.

Problem 1

One problem is that the statement is incorrect. For

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example, claims 1, 8, 22, and 26 state that the in-car device can receive a program from the ATM. Treyz does not show that.

As another example, claim 25 recites sending a PIN and data read from a card to the ATM. Treyz does not show that.

It may be true that Treyz can be programmed to perform the activities of these two examples, but that is a modification of Treyz, and has not been shown in the prior art.

Problem 2

The second problem is related to the first problem. As explained above, MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE** COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references can be combined
or modified does not render the resultant
combination obvious unless the prior art also
suggests the desirability of the combination.

. . . .

FACT THAT THE CLAIMED INVENTION IS **WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL** IN THE
ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior
art to meet the claimed invention would have
been "well within the ordinary skill of the
art at the time the claimed invention was
made" because the references relied upon
teach that all aspects of the claimed
invention were individually known in the art

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is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

The Office Action, in essence, is applying the two types of rationale prohibited by this MPEP section. That is, the Office Action is, in essence, stating that it is a simple matter to modify Treyz to attain the claimed invention.

Stated more simply, the PTO asserts that the device of Treyz is "capable" of performing what the claims recite. That is merely another way of stating that the device of Treyz "can be modified" to perform what the claims recite.

The MPEP section just cited explicitly prohibits this latter justification. The PTO is relying on this type of (prohibited) justification.

Point 9

Summary

The Final Action cites the Keller-Merck decisions, on "attacking references individually."

The Keller-Merck decisions actually hold that, in a combination of references, it is insufficient to argue that reference 1 fails to show claim element A, if another reference shows that element A. Simple logic supports this holding: the absence of element A from one reference is, in general, not fatal, if another reference shows element A.

Appellant is not making such an argument. Appellant argues that **NO REFERENCE** shows certain claim elements.

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That is not a Keller-Merck situation.

End Summary

The Final Action, page 4, relies on In re Keller and In re Merck & Co for the proposition that "one cannot show non-obviousness by attacking references individually, where rejections are based on combinations of references."

Appellant first points out that the quoted proposition, taken literally, makes no sense. Consequently, one must resort to the facts of Keller-Merck to understand what the proposition means.

Proposition, Taken Literally, Makes no Sense

Suppose, as here, that **none of the references show a certain claim recitation**. (The claimed transfer of the computer program to the in-car apparatus, as in claims 1, 8, 22, and 26, is found in none of the references.)

In such a case, Appellant would argue as follows:

The Treyz reference does not show this recitation.

The Swaine reference does not show this recitation.

Therefore, this recitation has not been shown in the applied references.

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Plainly, this argument is valid. Nevertheless, a literal reading of the Keller-Merck proposition would prohibit this argument, on the grounds that the "references are being attacked individually."

What Keller-Merck Proposition Actually Means

The resolution to this problem lies in the fact that a literal reading of the Keller-Merck proposition is not supported by the actual holding in Keller-Merck. Keller-Merck holds something different. The holding will be explained by way of example.

Assume that a **claim** recites elements A and B.

Assume that **reference 1** shows element A, but not B.

Assume, conversely, that **reference 2** shows element B, but not A.

These assumptions are repeated in tabular form:

ITEM	CONTENT
Claim	Recites A and B
Reference 1	Shows A, not B
Reference 2	Shows B, not A

Keller and Merck state that the following arguments **by themselves** are insufficient in this example.

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INSUFFICIENT ARGUMENTS

ARG_1: Reference 2 fails to show element A.

ARG_2: Reference 1 fails to show element B.

The reason for the insufficiency of the arguments is that, in Keller-Merck, the two references are being **combined**. **When combined**, elements A and B are present **in the combination**. Thus,

-- the absence of element A from Reference 2
is not relevant,

and

-- the absence of element B from Reference 1
is also not relevant.

Stated another way, the Arguments ARG_1 and ARG_2 given above, by themselves, as a matter of logic, do not rebut a rejection.

-- Even if Reference 2 fails to show element
A, Reference 1 could show that element.

-- Similarly, even if Reference 1 fails to
show element B, Reference 2 could show that
element.

Stated yet another way, Keller-Merck merely state that the **location** of the claim elements in the references is not relevant. Even if element A is not present in Reference 2, it can still be present in Reference 1, and so on.

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Appellant is not making this type of argument. Thus, Keller-Merck are not applicable.

Instead, Appellant points out that **even after combination**, elements of the claims are **still missing from ALL REFERENCES**. (In Keller-Merck, **after combination**, the claim elements **were not missing.**)

Comment on Keller-Merck Proposition

The proposition that it is improper to "attack the references individually etc." is not an accurate description of the holding in Keller-Merck. One reason is that such a proposition, taken in isolation, is vague, ambiguous, or both, as explained above.

A more accurate proposition would be that

One cannot show nonobviousness by asserting that a certain reference lacks a claim recitation A, when that recitation A is shown by another reference in the combination.

Appellant did not do that.

Therefore, in the present appeal, Appellant is not making the type of argument found in Keller and Merck. Appellant is not arguing that an individual reference lacks a teaching, which teaching is present in **another reference**.

Instead, Appellant argues that, even if the references are

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combined, claim elements are **still missing**.

Keller and Merck do not prohibit that type of argument.

Claim 4

Claim 4 depends from claim 1, and recites "retrieving cash or other valuable media dispensed from the terminal."

The Final Office Action relies on the first Office Action to justify the combination of references.

But no actual teaching in favor of combining the references has been given. The first Office Action, page 4, merely (1) sets forth elements supposedly found in Swaine and then (2) asserts that, "in light of the discussion of Swaine, above," it is obvious to add those elements to Treyz.

That, on its face, is invalid as a teaching under section 103. In general, the teachings of one reference do not suggest the (1) selection of specific elements of that reference and (2) the combination of those selected elements with another reference.

It is, of course, possible that such a teaching exists. If so, then the PTO must clearly identify such a teaching. The generalized, non-specific reference to "the discussion of Swaine, above," is insufficient.

MPEP § 706.02(j) states:

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Contents of a 35 U.S.C. 103 Rejection

. . .
To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . .
The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

Claim 8

Claim 8 recites:

means for receiving a computer program from the transaction terminal which generates an interface in the apparatus. (Original

Point 1

No receipt of a "computer program" in the claimed "in-car apparatus" has been shown in the references.

Nor has an "interface" which is generated by the "computer program" been shown.

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Point 2

Section 112 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof,

and

such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The claim recitation in question is a "means" recitation. The Office Action has not shown, in the prior art, the "corresponding structure" "described in the specification" or an equivalent to the recited "means."

Therefore, the claimed "means" has not been shown in the prior art.

ARGUMENT re: REJECTION OF CLAIMS 5 AND 6

Claims 5 and 8 are considered patentable, based on their parents.

In addition, the rationale for adding the Ramachandran reference to Treyz and Swaine is that

. . .doing so would allow the user to take advantage of the cashless digital wallet feature of a stored value card . . .

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(First Office Action, page 5.)

Ramachandran is cited to show the "stored value card." (See Abstract.) Thus, the rationale merely states that, if you add Ramachandran to the other references, you get the benefits of Ramachandran in those references.

That is not a valid teaching under section 103. If it were, then **every** combination of references would be obvious, because in every combination, you obtain the benefits of the individual references in the combination.

Further, the rationale sets forth a goal, namely, obtaining the benefits of a "stored value card." But pursuit of that goal does not lead, as a matter of logic, to the combination of references. If you want to attain the goal, then merely follow Ramachandran's teachings, without the other two references. The other two references are not needed to attain the goal.

Therefore, the stated goal does not lead to the combination of references.

Further still, Ramachandran teaches away from the present invention. He states that his "stored value card" is swiped into a portable terminal 14. That terminal 14 then communicates with a remote server, to handle the accounting required for the card. (Column 8, bottom, column 9, top.)

That is contrary to, or at least different from, the claimed

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concept of using a "facility" in a "vehicle" to perform a transaction with a "transaction terminal" which is "adjacent" the "vehicle."

- The card holder in Ramachandran is not in a vehicle.
- The card holder in Ramachandran does not perform a transaction with a "transaction terminal" as claimed.

ARGUMENT re: REJECTION OF CLAIMS 21 - 26

Claim 21

Point 1

Claim 21 states that "identification data" is entered into a "wireless device" which is maintained in a vehicle. The applied references do not show that.

- Swaine may show entry of PIN into the remote control 66. (Column 4, line 33.) However, Swaine's remote control 66 is not wireless, nor is it maintained in a vehicle.
- Treyz may show discuss entry of a PIN at column 30, line 54 et seq. However, the claim states that the ATM verifies the PIN. That has not been shown in Treyz. It may be that his PC performs the verification.

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Point 2

Claim 21 states that programs are transferred to the device, which generate an interface. Four locations of Treyz are cited to show this, namely,

- 1) column 50, lines 47 - 50;
- 2) Figure 9;
- 3) column 45, lines 22 - 25; and
- 4) column 47, lines 7 - 16.

These will be addressed individually.

The first location states:

The user may pay for the parking transaction using credit card information or other financial transaction information stored locally in automobile 12 or may use an account or other financial information arrangement that is maintained on a server or the like that is external to automobile 12.

Plainly, this does not show the claim recitations in question.

The second location (Figure 9) merely shows a display on a computer. (See column 4, lines 46 - 49). Plainly, that does not show the claim recitations in question.

The third location (column 45, lines 22 - 25) states:

Financial transactions may be involved in using automobile personal computer 14 to

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interact with wireless communications devices
over remote and local wireless links.

Plainly, that does not show the claim recitations in question.

The fourth location (column 47, lines 7 - 16) first discusses two transactions, namely, an ATM transaction and a highway toll payment, and then discusses which account of the customer will be charged in each transaction.

Then the fourth location states where account information necessary for charging the accounts (presumably credit card numbers and the like) is stored. Plainly, that does not show the claim recitations in question.

Therefore, the claimed (1) transfer of programs which (2) generate an interface have not been shown in Treycz.

Claim 22

Claim 22 recites transferring programs to a device maintained within a vehicle, which programs generate an interface in the device.

Those recitations have not been shown in the applied references. Thus, the rejections cannot stand.

MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

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The Final Office Action, page 2, bottom, attempts to show these recitations in the references by pointing to "software" supposedly found in Treyz at two locations: column 50, lines 47 - 50 and Figure 9.

However, Figure 9 merely shows a display on a computer. (See column 4, lines 46 - 49). Plainly, that does not show the claim recitations in question.

The other location states:

The user may pay for the parking transaction using credit card information or other financial transaction information stored locally in automobile 12 or may use an account or other financial information arrangement that is maintained on a server or the like that is external to automobile 12.

(Treyz, column 50, lines 47 - 50.)

Plainly, again, that does not show the claim recitations in question.

Other locations were cited by the PTO, but do not show the claim recitations in question, as explained in connection with claim 21, above.

Claim 23

Claim 23 states that a card is presented to the wireless device. Swaine is contrary, in stating that a card is presented

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to the card reader 48 of the ATM, not to his remote control.

(Column 4, lines 16 - 20.)

The PTO cites Treyz, column 32, lines 25 - 27, as showing a card reader in his PC. However, that is contrary to Swaine, who states that a card is presented to the ATM, not to any device within a vehicle, such as the PC of Treyz.

Contrary references cannot be combined.

Claim 25

Claim 25 recites:

a) maintaining a wireless communication device within a vehicle, said device comprising a keypad and a card reader;

. . .

d) inserting a card into the card reader.

e) entering a PIN into the keypad;

. . .

g) if the card and the PIN are accepted by the ATM, proceeding with a financial transaction.

These recitations have not been shown in the applied references.

A PC may be maintained in the vehicle of Treyz. But no entry of a PIN and card have been shown, followed by acceptance of the PIN and card **which are entered/inserted into the "device"**

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by an ATM.

The remote control unit 66 of Swaine is not "maintained" in the vehicle. Unit 66 is **permanently attached** to an ATM by cable 68. (See Figures 2 - 4). And no "card" is inserted into Swaine's remote control unit 66.

Claim 26

Claim 26 recites transferring programs to a device maintained within a vehicle, which programs generate an interface in the device.

Those recitations have not been shown in the applied references. Thus, the rejections cannot stand.

MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

The Final Office Action, page 2, bottom, attempts to show these recitations in the references by pointing to "software" supposedly found in Treyz at two locations: column 50, lines 47 - 50 and Figure 9.

However, Figure 9 merely shows a display on a computer. (See column 4, lines 46 - 49). Plainly, that does not show the claim recitations in question.

The other location states:

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The user may pay for the parking transaction using credit card information or other financial transaction information stored locally in automobile 12 or may use an account or other financial information arrangement that is maintained on a server or the like that is external to automobile 12.

(Treyz, column 50, lines 47 - 50.)

Plainly, again, that does not show the claim recitations in question.

Other locations were cited by the PTO, but do not show the claim recitations in question, as explained in connection with claim 21, above.

No Teaching Given for Combining References

In Rejecting Claims 21 - 26

The rationale given in the Final Office Action (page 3) for combining Treyz with Swaine is that

- 1) the devices in the two references are "similar in form and function" and
- 2) Treyz teaches using his device at ATMs.

However, several problems exist in this rationale.

PROBLEM 1

One problem is that the second part of the rationale (Treyz teaches using his device in ATM) does not, as a matter of logic,

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lead to a combination of the references. It is simply a supposed fact about the Treyz reference. The other reference is not needed for this fact to be true, nor for Treyz to operate as the fact asserts.

In any event, no line of reasoning has been given which shows how this fact leads to a combination which shows the claims.

PROBLEM 2

A second problem is that the mere fact that two references are "similar" is not, by itself, a teaching for combining the references.

Further, no definition of "similar" has been given. Thus, no determination can be made as to whether the PTO's assertion is correct or not.

Further still, the MPEP, § 2173.05(b), "Relative Terminology," section entitled "REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE," in part C, states that the term "similar" in claims is indefinite.

Therefore, since no definition has been given for the term "similar," and since the PTO has held "similar" to be indefinite, Appellant submits that the supposed "similarity" of the two references cannot be used as a basis for combining them.

PROBLEM 3

The undersigned attorney has examined the MPEP, and has examined Chisum's treatise on patents. Nowhere has he seen a rule which states that "similarity" of two references is a basis for combining them.

Therefore, Appellant requests, by way of Examiner's Answer, that a citation of authority be provided in support of the use of "similarity" as a basis for combining the references.

PROBLEM 4

A fourth problem is that the rationale is, in fact, erroneous. The two devices in the two references are not "similar."

-- The device in Treyz is a personal computer, PC, 14 in his Figure 3.

-- The device in Swaine is a remote control unit 66 in his Figures 2 - 4.

Those two devices are **completely different**. They perform **completely different functions**. They are not interchangeable. For example:

-- The PC 14 in Treyz can (1) run hundreds of off-the-shelf programs, (2) connect to the Internet, (3) store data on a hard drive, etc.

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-- The remote control unit 66 of Swaine is
nothing more than a simple "dumb terminal."
It is an input-output device.

Appellant repeats: those two devices are **completely different**. They perform **completely different functions**. They **are not interchangeable**.

The Office Action is incorrect in stating that the two devices are "similar."

Therefore, the rationale for rejecting claims 21 - 26 contains two parts. One part (namely, Treyz teaches using his device at an ATM) is irrelevant.

The other part (namely, the devices in Treyz and Swaine are "similar") is completely erroneous.

The rationale is not valid as a teaching for combining the references.

PROBLEM 5

A fifth problem is that no explanation has been given as to how this two-part rationale actually leads to the subject matter of claims 21 - 26.

That is, the Office Actions merely

-- assert that individual claim elements are
found in the two references and then
-- set forth the two-part rationale above,

as a justification for combining the elements supposedly found.

From another point of view, in analyzing the rejection, one starts with the two-part rationale. (One cannot start with the selected individual claim elements supposedly found in the references, because no basis exists for selecting those particular elements. The only basis would be Appellant's claims, which would be a selection based on hindsight.)

Thus, one starts with the two-part rationale for combining the references. Appellant now asks: given that two-part rationale, what is the logical basis for selecting the individual claim elements from the references, and combining those elements, based on this two-part rationale ?

Appellant answers this rhetorical question: there is no logical basis. (Or at least none has been given.)

Therefore, until a line-of-reasoning is given which (1) starts with the two-part rationale and (2) ends with the claimed subject matter, no valid teaching has been given in favor of combining the references.

PROBLEM 6

A sixth problem is that the two-part rationale is, in essence, identical to rationales which are prohibited by the MPEP.

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MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE** COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references can be combined
or modified does not render the resultant
combination obvious unless the prior art also
suggests the desirability of the combination.

. . .

FACT THAT THE CLAIMED INVENTION IS **WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE
ART** IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior
art to meet the claimed invention would have
been "well within the ordinary skill of the
art at the time the claimed invention was
made" because the references relied upon
teach that all aspects of the claimed
invention were individually known in the art
is not sufficient to establish a prima facie
case of obviousness without some objective
reason to combine the teachings of the
references.

The two-part rationale, in essence, states that (1) the
devices in the references are "similar" so that (2) any skilled
person would know how to combine the references, and thereby
obtain the claimed invention.

That is a forbidden rationale, as the MPEP sections just
cited indicate.

COMMENT

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The PTO gives a **single** rationale for combining Treyz with Swaine, in rejecting **multiple** claims, namely, claims 21 - 26.

The arguments given above against that rationale are considered to apply equally to each individual claim 21 - 26, and thus each claim is considered separately argued.


Appellant could repeat the arguments six times, once for each of the claims 21 - 26, but such repetition is considered unnecessary. The arguments apply to each of claims 21 - 26.

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CONCLUSION

Appellant requests that the Board overturn all rejections,
and pass all claims to issuance.

Respectfully submitted,


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ATTACHMENTS:

- 9. CLAIMS APPENDIX
- 10. EVIDENCE APPENDIX
- 11. RELATED PROCEEDINGS APPENDIX

8. CLAIMS APPENDIX - APPEALED CLAIMS

1. A method of conducting a transaction from within a vehicle, the method comprising the steps of:

 locating the vehicle adjacent a transaction terminal;
 transferring one or more computer programs from the transaction terminal to an in-car data entry facility maintained within the vehicle, which programs generate a user interface in the entry facility;

 entering user instructions into the in-car data entry facility; and

 transmitting the user instructions locally to the terminal for execution by the terminal.

2. A method in accordance with claim 1, further comprising the step of identifying the user.

3. A method in accordance with claim 1, further including the steps of transmitting data locally from the terminal to the vehicle, and displaying a part of the data on an in-car display located within the vehicle.

4. A method in accordance with claim 1, further comprising the step of retrieving cash or other valuable media dispensed from the terminal.

5. A method in accordance with claim 1, further comprising

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the step of uploading electronic valuable media to a memory storage device located within the vehicle.

6. A method in accordance with claim 1, further comprising the step of downloading electronic valuable media to the terminal from a memory storage device.

8. An in-car apparatus to be provided within a vehicle for user interfacing with a transaction terminal, the apparatus comprising:

means for interacting with a user;

means for receiving a computer program from the transaction terminal which generates an interface in the apparatus; and

means for transmitting data locally to a transaction terminal situated adjacent the apparatus.

10. An apparatus in accordance with claim 8, further comprising memory storage means for recording data.

21. A method, comprising:

a) maintaining a wireless communication device within a vehicle;

b) positioning the vehicle near an Automated Teller Machine, ATM;

c) establishing wireless communication between the

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wireless device and the ATM;

d) entering identification data into the wireless device, which data allows the ATM to verify identity of a user; and

e) if the ATM verifies the user, proceeding with a financial transaction.

22. Method according to claim 21, and further comprising:

f) transferring one or more computer programs from the ATM to the device, which programs generate an interface for the user.

23. Method according to claim 21, wherein the identification data is obtained from a card presented to the device.

24. Method according to claim 21, wherein the identification data is obtained from a keypad operated by the user.

25. A method, comprising:

a) maintaining a wireless communication device within a vehicle, said device comprising a keypad and a card reader;

b) positioning the vehicle near an Automated Teller Machine, ATM;

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- c) establishing wireless communication between the wireless device and the ATM;
- d) inserting a card into the card reader;
- e) entering a PIN into the keypad;
- f) relaying data from the card, and the PIN, to the ATM; and
- g) if the card and the PIN are accepted by the ATM, proceeding with a financial transaction.

26. Method according to claim 25, and further comprising:

- h) transferring one or more computer programs from the ATM to the device, which programs generate an interface for the user.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.